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OFFICE OF PETITIONS

In re Patent of Starkston et al. : DECISION ON REQUEST
Patent No. 7,772,090 : FOR RECONSIDERATION OF
Issue Date: August 10, 2010 : PATENT TERM ADJUSTMENT
Application No. 10/674,960 : and
Filed: September 30, 2003 : NOTICE OF INTENT TO ISSUE
Attorney Docket No. 884.949US1 : CERTIFICATE OF CORRECTION

This is a decision on the petition under 37 C.F.R. 1.705(d), filed October 12, 2010. Patentees request that the patent term adjustment indicated in the patent be corrected from one thousand two hundred seventy (1270) days to one thousand six hundred twenty-eight (1628) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted to one thousand six hundred twenty-eight (1628) days is **granted to the extent indicated herein.**

On August 10, 2010, the above-identified application matured into U.S. Patent No. 7,772,090. The instant request for reconsideration filed October 12, 2010 was timely filed within 2 months of the date the patent issued. See § 1.705(d). October 11, 2010 was a federal holiday. The Patent issued with a revised Patent Term Adjustment of 1270 days.

Patentees assert the Office failed to enter two additional periods of adjustment that occurred during the appellate period. The total of these asserted adjustments (330 is the number of days that is asserted) does not equal the amount of time that patentees desire to be added to the existing patent term adjustment. (It is noted that the number of days between November 24, 2007 and March 7, 2008 is not 321, as asserted by patentees, but rather 105 days.) Patentees have not provided an explanation of how their proposed 1628 day patent term adjustment is derived.

Nevertheless, the Office will address the petition and explain the correct patent term adjustment.

Office delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") is 301 days, which includes a new adjustment under 37 CFR 1.702(a)(2). A 34 day period of adjustment should be entered pursuant to 37 CFR 703(a)(5) for the delay in mailing a Notice of Allowance on April 5, 2010. On September 9, 2009, the Office mailed a BPAI decision where at least one allowable claim remained in the application. On November 2, 2009, applicants filed an additional amendment/argument and requested the Office reopen prosecution. On April 5, 2010, the Office mailed a Notice of Allowance. Accordingly, pursuant to 37 CFR 1.703(a)(2), a period of adjustment of 34 days is being entered for the period beginning on March 3, 2010, the day after four months after a reply to the BPAI decision was mailed, and ending on April 5, 2010, the date the Notice of Allowance was mailed.

Patentees argue there are two additional adjustments that occurred during the appellate period. First, patentees argue the Office should be charged with a 9 day period of adjustment because the Office failed to respond within four months to an appeal brief that was filed on February 12, 2007. Second, patentees argue the Office should be charged with a 105 day period of adjustment because the Office took 4 months and 105 days to mail an examiner's answer in response to the appeal brief, filed July 23, 2007.

With respect to patentees' first argument, the phrase "the date on which an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) means the date on which an appeal brief was filed. The phrase "appeal brief in compliance with 37 CFR 1.192" requires that" (1) the appeal brief fee be paid; and (2) the appeal brief complies with 37 CFR 1.192(c)(1) through (c)(9). In other words, the appeal brief must be in compliance in order for the Office's period to take action under 37 CFR 1.702(a)(2) to run. In this instance, the February 12, 2007 appeal brief was defective. A compliant appeal brief was not filed until November 23, 2007. Therefore, no adjustment is warranted. Patentees are informed that even if the Office's period for action had been running, that the reduction would have been subsumed within the 1092 day adjustment for successful appeal.

Patentees' second argument is not well taken, either because a 105 day adjustment, not a 330 day adjustment as patentees argue, under 37 CFR 1.702(a)(2) for the delay in mailing an examiner's

answer on March 7, 2008 to the compliant appeal brief, filed July 23, 2007, is subsumed within the 1092 day adjustment for successful appeal.

The total A Delay is 301 (267 + 34) days.

Office delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") is 284 days. The maximum B Delay period begins on October 1, 2006, which is one day after three years after the filing of the application on September 30, 2003, and ends on August 10, 2010, when the patent issued, and is 1410 days.

As stated in 35 U.S.C. 154(b)(1)(B)(ii), B delay does not include "any time consumed by appellate review by the Board of Patent Appeals and Interferences." The period of B delay does not include the 1092 day period beginning on September 14, 2006, the date the Notice of Appeal was filed, and ending on September 9, 2009, the date the Board of Patent Appeals and Interferences issued a decision reversing the examiner in part. Excluding the 1092 days consumed by appellate review, and the 34 days of overlap (see discussion above of new ground for adjustment above) results in a period of B delay of 284 days (1410 - 1092 - 34).

Although the 1092 days consumed by appellate review is not part of the period of B delay, the 1092 days does constitute delay under 35 U.S.C. 154(b)(1)(C) ("C delay"). In other words, the successful appellate period of 1092 days is counted against the Office as a separate adjustment pursuant to 37 CFR 1.702(e) as C delay.

The period of Applicant Delay is 89 days.

In light thereof, the correct patent term adjustment is one thousand five hundred eighty-eight (1588) days, which is 301 (267 + 34) days of delay under 35 U.S.C. 154(b)(1)(A) + 284 days of delay under 35 U.S.C. 154(b)(1)(B) + 1092 days successful appeal period under 37 CFR 1.702(e) minus 89 days of Applicant Delay.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand five hundred eighty-eight (1588) days.**

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley
Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,772,090 B2

DATED : August 10, 2010

DRAFT

INVENTOR(S) : Starkston et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1270 days

Delete the phrase "by 1270 days" and insert – by 1588 days--